

## **REMARKS**

### **INTRODUCTION**

Claims 1-28 were previously pending and under consideration.

Claim 30 is added herein.

Therefore, claims 1-28 and 30 are now pending and under consideration.

Claims 1-28 are rejected.

Claims 1, 7-9, 14-16, and 21-28 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

### **RELIANCE ON OFFICIAL NOTICE OR PERSONAL KNOWLEDGE**

Applicant has twice traversed the Examiner's past reliance on Personal Knowledge and/or Official Notice. In an Amendment filed February 19, 2003, Applicant stated that:

In sum, the personal knowledge of the Examiner, when used as a basis for a rejection, must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by applicant. See, e.g. 37 C.F.R. § 1.104(d)(2). The rules of the U.S. Patent and Trademark Office do not allow discretion on the part of the Examiner. Either the Examiner must support this assertion with an Affidavit or withdraw the rejection. The Examiner is requested to support the rejection with either an affidavit or a reference, or withdraw the rejection.

In an Office Action issued May 20, 2003, the Examiner stated "... the Examiner will not provide any written document to support the public disclosure presented in the office action ..." (p. 3, lines 15-16).

In an Appeal Brief filed November 20, 2003, Applicant again pointed out that:

... Official Notice is not proper, as in this case, where the asserted fact is not capable of instant and unquestionable verification as being well known. Examples of facts that may be Officially Noticed include: a flame intensity may be adjusted according to a heat requirement; the weight of an element in the

periodic table; or that a tape recorder erases when recording. Furthermore, assertions of specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420. The Official Notice in the present rejection is not of the type that is capable of instant verification and is based on specific knowledge of the Examiner. This conclusion is confirmed by the Examiner's remark at an Interview that multiple searches for documentary support found none. A prima facie case of obviousness has not been made.

Furthermore, the nature of the Official Notice taken by the Examiner is so broad that it amounts to an assertion of personal knowledge of the general state of the art at the time of the present invention, rather than an assertion of a particular fact subject to instant verification. For example, in responding to the Applicant's traversal of the use of Official Notice, the Examiner characterized the nature of the Officially Noticed facts as "business strategies practiced or used by professionals in the art in the 1990's ... strategies or methods [that] have been used or practiced in the industry form many years well before the filing date of the Instant Application" (page 3, lines 11-18 of the May 20, 2003 Office Action). See In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("We reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice", emphasis added).

Furthermore, as stated in In re Zurko, 258 F.3d at 1385 (59 USPQ2d at 1697), "the Board [PTO] cannot simply reach conclusions based on its own understanding or experience— or on its assessment of what would be basic knowledge or common sense. Rather, the Board [PTO] must point to some concrete evidence in the record in support of these findings" (emphasis added). The Examiner's personal understanding and experience is not concrete evidence in the record.

If the Examiner's statements are Officially Noticed facts (Official Notice was not formally noted), then they are improper because they are statements regarding the state of the art. "[A]ssertions of specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art", In re Ahlert, at 1091 (165 USPQ at 420) (emphasis added).

In sum, the state of the prior art can be supplied by: printed publications; an applicant's admissions; or a sworn Examiner's Affidavit. The Examiner's rejection relies on multiple pages of purported art that the Examiner has explicitly identified as personal knowledge. This information cannot be relied on unless it is sworn as true in an Examiner's Affidavit. Furthermore, as stated in Ahlert, the specific state of the prior art is not permitted to be Officially Noticed.

An Examiner must support statements of personal knowledge with a sworn Affidavit or documentary support ("[i]f Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence", MPEP §2143.02(C)). Applicant has traversed the Examiner's inappropriate reliance on personal knowledge on two separate occasions, most recently in an Appeal Brief filed at considerable expense to the Applicant. Applicant has previously, and above, specifically pointed out supposed errors in the Examiner's action (e.g. state of prior art not officially noticeable, Examiner acknowledged at Interview that multiple searches failed to find supporting references, which business strategies are in use at any given time is not a fact capable of instant and unquestionable verification, etc.) Applicant again respectfully requests the Examiner to either withdraw the unsupported statements or support same with an Affidavit, as unconditionally required by 37 C.F.R. § 1.104(d)(2).

It is respectfully noted that any new basis for rejecting claims 9-15, 21, 23, and 25-28 will not have been necessitated by their amendment, and therefore must be Non-Final.

#### **EXAMINER NOT RESPONDING TO PREVIOUS ARGUMENT**

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP § 707.07(f), a failure of the Examiner to address the Applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address

the Applicant's traversals would render the Examiner's decision to again-reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the Applicant's traversals of Personal Knowledge and/or Public Notice presented in the Amendment of February 19, 2003 and the Appeal Brief filed November 20, 2003, it is respectfully requested that the Examiner issue a new Non-Final Office Action addressing the Applicant's traversals.

#### **CLAIM OBJECTIONS**

At page 3 of the Office Action, claims 22-24 were objected to as "inconsistent", claims 7 and 8 were objected to as confusing.

Claim 22 was objected to as inconsistently reciting "finding in response to interactively identifying the promoting commodity". Claim 22 does not recite the quotation provided by the objection, the objection does not explain what is inconsistent, and no inconsistency exists. Withdrawal of the rejection is respectfully requested. Claims 23 and 24 were similarly objected to without explanation. Clarification of the objection or withdrawal of the same is respectfully requested.

Claims 7 and 8 recite "used", which has been interpreted by the Examiner as a verb. However, in view of the specification and a reading that follows rules of grammar, "used" should be interpreted as an adjective, indicating, for example, a thing "that has endured use; specifically: SECONDHAND <a used car>". For improved grammatical clarity, commas have been inserted in claims 8, 14, and 20. Withdrawal of the objection is respectfully requested.

#### **REJECTIONS UNDER 35 USC § 101**

In the Office Action, at pages 3-7, claims 1-9, 13-15, 19, 20, and 22-25 were rejected under 35 U.S.C. § 101 for the reasons set forth therein.

Double Patenting

At page 4 of the Office Action, claim pairs 7-8, 13-14, and 19-20 were rejected as doubly patenting. Claim 7 has been amended to recited "new" products, which differs from the "used" products of claim 8. Claim pair 13-14 and claim pair 19-20 were each rejected as duplicative. The paired claims are not duplicates (note, "new" versus "used" products). Withdrawal of the rejection is respectfully requested.

Statutory Subject Matter

Claims 1-8, 9, 15, and 22-25 were rejected as directed to non-statutory subject matter. The claims are amended to recite "computing" apparatuses and "computer-implemented" methods. As stated in State Street Bank & Trust Co. and Toma (cited at page 6 of the Office Action), computer implemented processes and computerized systems (i.e. apparatuses) are statutory technological arts. Withdrawal of the rejection is respectfully requested.

**REJECTIONS UNDER 35 USC § 102**

In the Office Action, at pages 7-9, claims 1-8, 16-20, 22, and 24 were rejected under 35 U.S.C. § 102 as anticipated by Jermyn. This rejection is traversed and reconsideration is requested.

JERMYN DOES NOT PROVIDE DIFFERENT CUSTOMER-SPECIFIC PRODUCT DESCRIPTION INFORMATION TO DIFFERENT CUSTOMERS TO PROMOTE THE SAME PARTICULAR PROMOTION PRODUCT

Amended claim 1, for example, recites:

a determiner that individually fits a product description to the transaction tendencies of each of the target customers determined by the transaction tendencies analyzer by selecting a product description, from among a plurality of different pre-existing product descriptions, each different product description having different product description content that corresponds to respective transaction tendencies of the target customers; and

using the individually fitted product descriptions so as to individually inform the target customers of the particular promoting product, whereby the same particular promotion product is

promoted to the target customers using the different customer-specific product descriptions.

In other words, for different customers found based on the same particular promotion product, the target customers are provided with different customer-specific product descriptions found by analysis of the customer's transaction tendencies.

In contrast, the coupons or equivalents in Jermyn (a) target a product *category* rather than a particular product, and (b) do not provide different customer-specific product descriptions for a particular product, but rather provide varying levels of incentive for items in a product category.

The purpose of Jermyn is to improve the effectiveness of marketing with coupons. Jermyn starts with a product category ("select consumer households that have purchased products falling within defined product categories", col. 2, lines 15-17; "selecting a product *category* for promotion", col. 2, lines 45-46; "a selection is made of at least one promoted product category and a promotion theme", col. 6, lines 57-58; "[t]he selected promotional theme typically promotes a selected brand or brands within the selected product category or categories", col. 7, lines 22-24). Examples of product categories mentioned by Jermyn include "healthy diet selections", which would contain "a *wide variety* of low-fat foods" (col. 6, lines 59-61). The customers to be targeted are selected because they "have purchased products that fit with the current theme" (col. 7, lines 7-10). A theme or wide category is not equivalent to a particular product.

The category-based selection of customers in Jermyn is significant because no particular product is being promoted; a broad theme or category is being promoted. Therefore, Jermyn does not disclose the recited features of "marketing a particular promotion product", or finding "previously purchased products that are suitable to be replaced by the particular promotion product". In contrast, Jermyn markets a product category. Previous purchases are matched to the category or theme being promoted, and no particular product is promoted.

To the extent that in Jermyn there may be many particular products within the targeted product category or theme, such products are not fitted with individualized or tendency-specific product information. Claim 1, for example, recites "individually fit[ting] a product description to the transaction tendencies of each of the target customers determined by the transaction

tendencies analyzer by selecting a product description, from among a plurality of different pre-existing product descriptions, each different product description having different product description content that corresponds to respective transaction tendencies of the target customers". The effect being that "the same particular promotion product is promoted to the target customers using different product descriptions". In other words, to promote the particular promotion product, different custom-fit product descriptions are provided to different customers, according to their purchasing tendencies.

As discussed above, in Jermyn a particular product is not promoted, rather a category is promoted. Therefore, there is no discussion of "inform[ing] the target customers of the particular promoting product" with customized information. The promotion category of Jermyn is used to find customers, but the customers, once identified, are targeted for any variety of products related to the promotion category.

Furthermore, Jermyn does not discuss different product descriptions for informing customers of the same particular promotion product. Jermyn does not disclose product descriptions. Jermyn incents individual customers by either selecting which products to target toward the individual, by varying the amount of value associated with a coupon for the individual, or by providing information allowing a customer to obtain a free sample. In the case of varying the value of a coupon, different customers receive different coupon values (according to their profile) rather than different product descriptions for the same particular product; a coupon value is not "description content that corresponds to respective transaction tendencies of the target customers". In the case of providing information to obtain a free sample, Jermyn only discusses providing a phone number (col. 7, lines 48-51). No customizing of product information to promote a same particular product is directed to customers that were identified using the particular promotion product.

In sum, an aspect of the invention promotes or introduces a particular product by customizing production description information to fit the differing tendencies of different customers and by using that customized product description to promote a same particular product. Consumers benefit because they receive personally pertinent information, and a seller of a product also benefits because different consumers are more likely to purchase a product if they are informed in view of its relevance with respect to their differing individual preferences or

tendencies. In a general sense, an aspect of the present invention customizes, e.g., a sales pitch, and Jermyn and Deaton customize a purchasing incentive by choosing which products to coupon and by varying the level of discount of the coupons. Customers in Jermyn and Deaton are informed of discounts available to them, but they are not informed with customized description.

Withdrawal of the rejection is respectfully requested.

Applicant notes that the selected product descriptions discussed above provide customer-specific information corresponding or relevant to the particular promotion product (vis-à-vis the transaction tendencies), but the selected descriptions are not recited to require direct description of or direct reference to the particular promotion product. Furthermore, the claim changes do not narrow the claims, which previously recited individually fitting product introduction to customers.

### **REJECTIONS UNDER 35 USC § 103**

In the Office Action, claims 9-15, 21, 23, and 25-28 were rejected under 35 U.S.C. § 103 as obvious over Deaton combined with Jermyn. This rejection is traversed and reconsideration is requested.

Claims 9-15, 21, 23, and 25-28 are distinguishable based on the arguments above relating to Jermyn. Deaton is not cited for and does not discuss or suggest the features cited above.

At page 9 of the Office Action, Deaton is cited as "selecting product introductions or product promotions to target the particular customer based on his prior transaction tendencies by issuing a coupon corresponding to a product promotion to the particular [customer] so as to encourage the customer to purchase the promoted product in an effort to patronize a new product is implicitly disclosed in the current reference (col. 71:31-67)".

In contrast to the claims rejected as obvious, the cited portion of Deaton relates to generating coupons, which are "a part of a printed advertisement to be cut off to use as an order blank or inquiry form or to obtain a discount on merchandise" (Merriam Webster's Dictionary). The purpose of a coupon is to obtain a discount, which is not the same as providing



personalized product description information. Deaton does not discuss or suggest promoting a same particular product to different customers by using different customer-specific product description information when promoting the same particular product. Deaton, like Jermyn, is concerned with customizing coupons by selecting the products to be couponed and by determining the level or the level of incentive of a coupon. Neither customization is analogous to customizing product description information to promote a particular promotion product to different customers, where the different product descriptions are selected according to the different transaction tendencies of the different respective customers.

#### Examiner's Personal-Knowledge Art is Not *Prior Art*

At various places, including pages 21-23, the rejection relies on the *current* state of the art as teaching features of claims 9-15, 21, 23, and 25-28. However, MPEP § 2106 states that "one must determine whether the invention would have been obvious at the time the invention was made", and MPEP § 2116.01 states that "the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, applicant's claimed invention would have been obvious." It is well established that a patent application is tested for novelty and non-obviousness based on the state of the art *at the time of the invention or when an application was filed*.

However, the rejection relies on the Examiner's undated personal knowledge of the *current* state of the art; "can target", "many ... encourage", "old systems can be sold", "legacy systems can be donated", there are companies in the USA that are involved in ...", Gateway 2000 ... promises or advertises that the customer can ...", etc. (emphasis added).

By its own admission, the rejection does not to establish a prima facie case of obviousness.

Withdrawal of the rejection is requested for failure to establish that all of the features of the rejected claims are found in the *prior* art.

#### **DEPENDENT CLAIMS**

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of

independently distinguishing features. For example, claim 3 recites "a product type conversion table that converts a product type into at least one transaction tendency of the target customer". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

#### **NEW CLAIM 29**

New claim 29 has been added to clarify customizing of product information. Claim 29 is distinguishable based on similar arguments regarding Jermyn and Deaton.

#### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

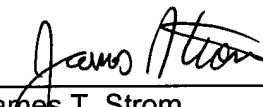
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 17 May 2004

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